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APPLICATION NO.	FILING DATE	CAERAN	FIRST NAMED INVENTOR	M	ATTORNEY DOCKET NO.
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QM12/0208

MOHANDES EXAMINER

37ART UNIT

PAPER NUMBER

02/08/06

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/537,176

Applicant(s)

CAERAN, MARCO

Examiner

Jila M. Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

1. Claims 15 and 19-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5. Under MPEP 809 and 809.02 (a) there is no requirement to prove whether there is a serious burden on the examiner to examine the species. If applicant's traverse is based upon an admission that the species identified are not patentably distinct, applicant should admit on the record that this is the case.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

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4. The specification is objected to under 37 CFR 1.71 because it fails to provide an adequate description of the invention. Neither the lasting allowance or how each of the lower ends of the frame are being fixed to the lasting allowance has been clearly disclosed in a manner commensurate with the requirement of the statute.

5. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It has not been clearly disclosed as how each of the lower ends of the frame are being fixed to the lasting allowance.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-14 and 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1, 13 and 14 the phrase "made of a flexible substantially non-stretchable material" is vague and indefinite. It is not clear what structure such language would encompass rendering the claims indefinite. In claim 1, the phrase "along a preferred directions of forces/supports" is incomplete vague and indefinite, since there no reference line has been established. In claim 3, the phrase "at least one lateral arm comprises two substantially symmetrical lateral arms" is inaccurate and indefinite. It is not clear what structure such language would encompass. In claims 9 the phrase "lasting allowance" is vague and indefinite. It is not clear what structure such language would encompass with reference to Figure

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6 and 7. In claim 14 the phrase "arranged so as to provide a predetermined moment of inertia along predetermined direction" has no clear meaning rendering the claim indefinite.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 1-3, 5 and 13-14 rejected under 35 U.S.C. 102(b) as being anticipated by Spier (3,807,062). Spier '062 discloses all the limitations of the claims such as a sports boot comprising an outer sole and an external upper overlying the outer sole and covering the user's foot and lower leg, the upper including a flexible frame. See column 3, lines 14-21.

10. Claims 1-8, 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Saillet (5,901,469). Saillet '469 discloses all the limitations of the claims such as a sports boot comprising an outer sole and an external upper overlying the outer sole and covering the user's foot and lower leg, the upper including a flexible frame. See Figure 3 embodiment.

11. Claims 1-3 and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown (4,869,001). Brown '001 discloses all the limitations of the claims such as a sports boot comprising an outer sole and an external upper overlying the outer sole and covering the user's foot and lower leg, the upper including a flexible frame. See figure 36 embodiment.

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12. Claims 1-8, 10-14 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoshizaki et al. (5,498,033). Hoshizaki '033 discloses all the limitations of the claims such as a sports boot comprising an outer sole and an external upper overlying the outer sole and covering the user's foot and lower leg, the upper including a flexible frame. See column 2, lines 11-13 and Figures 1 and 4 embodiments

Conclusion


13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is 703-305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

JMM
February 7, 2001


Paul T. Sewell
Supervisory Patent Examiner
Group 3700